

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
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Michael HERMANN) Group Art Unit: 2872
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Application No.: 09/817,797) Examiner: Audrey Y. Chang
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Filed: March 27, 2001) Confirmation No. 8356
	:
For: DEVICE FOR QUANTITATIVE)
ASSESSMENT OF THE ALIGNED	:
POSITION OF TWO MACHINE)
PARTS, WORKPIECES OR THE LIKE	:

PETITION UNDER 37 CFR 1.181(a)(1) & (3)

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby seeks review of the actions of the Examiner described below and invokes the supervisor authority of the Director to implement the corrective actions requested herein.

Statement of the Facts

In section 6, spanning pages 7 & 8 of the final Office Action, the Examiner “objected” to claims 1, 3 & 4 stating:

Claims 1 and 3-4 have been amended to include the phrases “known location”, that is *confusing and indefinite* since it is not clear with respect to what are these known locations defined this is to say that it is not sure if these known locations are measured in the same coordinate system or not?
(Emphasis added)

It is standard Office practice to “reject”, not object, to claims that are “confusing and indefinite,” with 35 USC § 112, second paragraph being used as the basis for doing so. That is, as set forth in MPEP § 2171: “If the claims do not particularly point out and distinctly

claim that which applicants regard as their invention, the appropriate action by the examiner is to reject the claims under 35 U.S.C. 112, second paragraph.” Furthermore, objections are contrasted with rejections in MPEP § 706.01, where it is pointed that if “the form of the claim (as distinguished from its substance) is improper, an ‘objection’ is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable.”

The mischaracterization as an objection of what is clearly a matter of substance that should have been made subject to a rejection under 35 USC § 112 has very real consequences since, as also noted in MPEP § 706.01:

The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the *>Director of the USPTO<.

Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.

Thus, by improperly characterizing as an objection, subject matter that Office practice clearly indicates should be made the subject matter of a rejection under 35 USC § 112, second paragraph, the Examiner is attempting to shield her action from review by the Board of Appeals and depriving applicant of a right it should have to seek Board review of claim language that the Examiner is contending is “confusing and indefinite.”

In applicant’s Appeal Brief, it was stated that the above-noted “objections are in reality a rejection under 35 USC § 112 and should be treated as such” since the “confusing and indefinite” is the language normally used for a rejection under 35 USC § 112, second paragraph. On July 10, 2008, a Notification of Non-Compliant Appeal Brief was issued by the Examiner in which she held that:

The brief fails to provide the proper statement concerning the grounds of rejection. The final rejection of the application does not raise rejection [*sic*] under 35 USC 112, second paragraph. The objection to the claims cannot be converted to rejection under 35 USC 112, second paragraph.

In responding to this notification, applicant is submitted that deeming applicant's Brief non-responsive on this basis is improper and it is for the Board, not the Examiner to determine if what the Examiner has categorized as an objection is, in fact, a rejection under 35 USC 112, second paragraph and set forth applicant's basis therefor.

On October 2, 2008, the undersigned was contacted by the Examiner and advised that applicant's Brief was still deemed to be improper and that a petition should be filed, and on October 10, 2008, a formal Notification of Non-Compliant Appeal Brief was issued again holding that applicant's categorization of the Examiner's objection as a rejection was improper.


Action Requested

In the alternative, it is requested that the Director either:

(1) Determine that the basis of the Examiner's objection should properly have been presented as a rejection and that the treatment of such as a rejection in applicant's Appeal Brief was therefore proper so that the Appeal Brief is fully compliant and the objection is to be treated by the Examiner as a rejection in the Examiner's Answer; or

(2) Withdraw the objection on the basis that the claims objected to are not "confusing and indefinite" for the reasons set forth in the appended Memorandum.

Respectfully submitted,

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Memorandum in Support of Petition

The Examiner has stated in her objection to claims 1, 3 & 4 that “the phrases ‘known location’, is confusing and indefinite since it is not clear with respect to what are these known locations.” To support her position, the Examiner has merely conjectured reasons why one might find the claims indefinite with reference to the possibility of different coordinate systems being used, but provides no evidence which would indicate that such views would be considered problems by one working in this field. On the other hand, applicant submitted a Declaration of Roland Hölz (a copy of which is appended to this Petition) in which the Declarant Hölz explains in detail in paragraph 4 of his declaration why “the ‘known location’ recitation found in claims 1 & 3 would be found to be clear and definite by one of ordinary skill in the art” for specific reasons. The Examiner’s position is tantamount to saying that if one puts something in a specific spot, that person would not know its location. Furthermore, contrary to the Examiner’s position, the coordinate system used to identify the “known” location is irrelevant, as is whether multiple coordinate systems are used since known techniques exist for converting from one coordinate system to another, e.g., geodetic to XYZ, and in fact, commercial software programs are readily available that can convert and transform spatial data between any of the hundreds of known coordinate systems. Therefore, the Examiner’s naked suppositions have been rebutted by established fact, so that no justification exists for continued objection to claims 1, 3 & 4 as being confusing and indefinite.